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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/009,873   | 11/01/2002  | Anand Ranganathan    | SHW-009US           | 4622             |
| 959  | 7590        | 06/08/2007           | EXAMINER            |                  |
| LAHIVE & COCKFIELD, LLP<br>ONE POST OFFICE SQUARE<br>BOSTON, MA 02109-2127 |             |                      | LU, FRANK WEI MIN   |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1634   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 06/08/2007   |             | PAPER                |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|   |                                |                         |
|---|--------------------------------|-------------------------|
| <b>Advisory Action<br/>Before the Filing of an Appeal Brief</b> | <b>Application No.</b>         | <b>Applicant(s)</b>     |
|   | 10/009,873                     | RANGANATHAN, ANAND      |
|   | <b>Examiner</b><br>Frank W. Lu | <b>Art Unit</b><br>1634 |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a)  They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b)  They raise the issue of new matter (see NOTE below);  
 (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,3-17 and 21.

Claim(s) withdrawn from consideration: 18-20.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.

13.  Other: \_\_\_\_\_.

**DETAILED ACTION**

**ADVISORY ACTION**

1. The proposed amendments filed on April 2, 2007 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

***Response to Arguments***

In page 10, third paragraph bridging to page 15, second paragraph of applicant's remarks, applicant argues that the amendments on claims 1, 4-7, 9, and 10 have overcome the rejections under 35 USC 112, second paragraph.

This argument has been fully considered and is moot since claim 1 is amended by adding a phrase "inserting a next desired DNA unit provided in step a) into the cleaved ligated product from step d), thereby generating a next ligated product, and bringing the next ligated product into contact with a DNA methylase such that the restriction site at the 3' end of the next desired DNA unit in the next ligated product is abolished, thereby generating a next ligated product containing a DNA modification, f) cleaving the next ligated product containing a DNA modification generated in step e) with said restriction enzyme such that said 5' restriction enzyme recognition sequence of said next desired DNA unit is cleaved", claim 4 is amended by adding a phrase "e) inserting a next desired DNA unit provided in step a) into the cleaved ligated product from step d), thereby generating a next ligated product, and using the next ligated product to transform a dam+ strain of *E. coli*, thereby generating a next ligated methylated product, f) recovering the next ligated methylated product from step e) and cleaving the next ligated product at an accessible XbaI site with XbaI, such that said 5' XbaI restriction enzyme recognition sequence of said next desired DNA unit is cleaved", claim 9 is amended by adding a phrase "d) cleaving a

next desired DNA unit provided in step b) with the second and third restriction enzymes, thereby generating a cleaved next desired DNA unit, e) ligating the cleaved product from step c) with the cleaved next desired DNA unit from step d) to form a next ligated product such that the ligation of the cleaved product and the cleaved next desired DNA unit abolishes the recognition site for the first restriction enzyme at a ligation junction of the cleaved product and the cleaved next desired DNA unit, and cleaving the next ligated product with said first restriction enzyme, thereby generating a next cleaved product”, and claim 10 is amended by adding a phrase “d) cleaving a next desired DNA unit provided in step b) with Spe I and Sma I, and dephosphorlating the 5' end of the cleaved next desired DNA unit, thereby generating a cleaved dephosphorlated next desired DNA unit, e) ligating the cleaved product from step c) with the cleaved dephosphorylated next desired DNA unit from step d) to form a next ligated product and cleaving the next ligated product with XbaI”. Furthermore, in view of step a) and c) of the amended claim 1 or 4, since step a) of claim 1 or 4 generates a cleaved DNA unit, it is unclear how to insert an uncleaved DNA into the cleaved DNA construct as recited in step c) of claim 1 or 4. These new amendments in claims 1, 4, 9, and 10 raise new issues that would require further consideration and/or search.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Art Unit: 1634

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

May 29, 2007

  
FRANK LU  
PRIMARY EXAMINER